THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GURUDUS D. SINAI-ZINGDE

Appeal No. 94-0377
Application 07/851,820[1]

ON BRIEF

Before KIMLIN, TURNER and WEIFFENBACH, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection 1, 2, 7 and 8. Claims 4, 6, 9 and 10, the other claims remaining in the present application, have been allowed by the examiner. Claim 1 is illustrative:

[1] Application for patent filed March 16, 1992.

1. A nitrogen-containing polymer formed by the reaction of a polyketone copolymer, formed by a polymerizing carbon monoxide and at least one olefin, and an amino acid or derivative thereof.

In the rejection of the appealed claims, the examiner does not rely upon prior art.

Appellant's claimed invention is directed to a nitrogen-containing polymer formed by the reaction of a polyketone copolymer and an amino acid or derivative thereof. The polyketone copolymer is formed by polymerizing carbon monoxide and at least one olefin.

Appealed claims 1, 2, 7 and 8 stand rejected under 35 U.S.C. 112 first and second paragraphs.

Upon careful consideration of the opposing arguments presented on appeal, we will not sustain the examiner's rejection.

According to the examiner, appealed claim 1 runs afoul of § 112, second paragraph, because the claim language "the reaction of a polyketone copolymer... and an amino acid..." is vague and indefinite. However, it is well-settled that claim language is not considered in a vacuum but in light of the supporting specification and teachings of the prior art as it would be interpreted by one having ordinary skill in the relevant art. In re Sneed, 710 F.2d 1544, 218 USPQ 385 (Fed. Cir. 1983);

In re Kroekel, 504 F.2d 1143, 183 USPQ 610 (CCPA 1974); In re Moore, 439 F.2d 1232, 169 USPQ 236 (CCPA 1971). While the examiner is concerned that the appealed claims do not recite the reaction parameters, it is sufficient for purposes of § 112, second paragraph, that the specification herein discloses that "[T]he nitrogen-containing polymers of the present invention can be rather easily formed by heating the polyketone and the amino acid in a suitable organic reaction solvent, such as an alcohol, with an amine, which is believed to function as a catalyst." (Page 3 of specification). The examiner has not sufficiently explained why one of ordinary skill in the art would have any difficulty in understanding the meaning of the criticized claim language. The examiner is reminded that it is not the purpose of the claims to include every detail of an applicant's invention. That function is left to the specification. In re Johnson, 558 F.2d 1008, 194 USPQ 187 (CCPA 1977).

It is also the examiner's position that the appealed claims are based upon a specification that does not fulfill the enablement requirement of § 112, first paragraph. The examiner reasons that since the specification does not set forth the operable limits of the reaction heating, one of ordinary skill in the art would have to resort to undue experimentation to determine the specifics of the heating step. We do not agree. As noted above, page 3 of the specification discloses that the

inventive polymers can be easily formed by heating and the specification further provides ten examples of various reactions, all of which simply employ heating to reflux. In our view, the specification provides sufficient guidance for one of ordinary skill in the art to practice the claimed invention without undue experimentation.

The examiner also notes that the specification examples are limited to reactions with alpha amino acids, whereas the appealed claims are not so limited. The examiner states "it is not clear that refluxing applies to amino acids other than alpha amino acids, e.g. amino benzoic acid, etc." (Page 3 of answer). However, the examiner does not satisfy his initial burden in establishing a prima facie case of non-enablement simply by expressing doubt that the claimed method is operable when reactants other than those exemplified are used. It is the examiner's burden at the outset to establish with objective evidence or scientific reasoning a legitimate concern that processes within the scope of the appealed claims are not enabled by the specification. Here, the examiner has presented no such evidence or reasoning. It is axiomatic that the examiner must establish a reasonable basis for doubting the truth of appellant's assertions in the specification. In re Strahilevitz, 668 F.2d 1229, 212 USPQ 561 (CCPA 1982); In re Armbruster, 512

F.2d 676, 185 USPQ 152 (CCPA 1975); and In re Marzocchi, 439 F.2d 220, 169 USPQ 367 (CCPA 1971).

Accordingly, based on the foregoing, the examiner's decision rejecting the appealed claims is reversed.

REVERSED

EDWARD C. KIMLIN)
Administrative Patent Judge)
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VINCENT D. TURNER)
Administrative Patent Judge) BOARD OF PATENT
) APPEALS
) AND
CAMERON WEIFFENBACH) INTERFERENCES
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